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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/849,147	05/04/2001	Jacob J. Liu	56647USA8A.002	9714
32692	7590	10/31/2003	EXAMINER	
3M INNOVATIVE PROPERTIES COMPANY			ZIRKER, DANIEL R	
PO BOX 33427			ART UNIT	PAPER NUMBER
ST. PAUL, MN 55133-3427			1771	

DATE MAILED: 10/31/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

Applicant(s)

Examiner

Group Art Unit

— The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE -3- MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- ☒ Responsive to communication(s) filed on 7/18/03
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

### Disposition of Claims

- ☒ Claim(s) 1-8, 10, 11, 19-23 is/are pending in the application.
- Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 1-8, 10, 11, 19-23 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement

### Application Papers

- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- ☐ All ☐ Some\* ☐ None of the:
- ☐ Certified copies of the priority documents have been received.
- ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
- ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

\*Certified copies not received: \_\_\_\_\_

### Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other \_\_\_\_\_

Office Action Summary

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. Claims 1-8, 10, 11 and 19-23 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention. More particularly, it seems clearly proper to characterize the invention as a "repositionable label" as was originally the case, rather than just ~~as~~ the vague and indefinite statement "article". In claim 2 applicants should be aware that they are claiming a "block copolymer elastomer", not a "block copolymer" and as claim 2 now reads, it is believed that only one polystyrene block <sup>in</sup> ~~and~~ one molecule of the entire elastomer would be necessary to meet the claim. In claim 10 it is believed that it should be "pounds per a unit area", not just "pounds". Also, in claim 20 it appears desirable to change "adhesive" to a --repositionable non-pressure sensitive adhesive--.

3. Claims 1-8, 10, 11 and 19-23 are rejected under 35 U.S.C. § 103(a) as being unpatentable over either EP -263 or Bird, each combined with applicants' admissions in the specification at page 2, lines 8-11 and 20-22 and page 3 lines 1-4 and 18-21. EP -263 is again relied upon substantially as previously set forth, disclosing (page 2, lines 3-5) adhesive tapes that are repositionable, even after being adhered to a

substrate for prolonged periods of time, and also a repositionable genus of articles that can comprise a label which can be cleanly removed from substrates to which it is applied, the adhesive being a low tack or tack-free elastomeric block copolymer adhesive that is believed to either read upon or is at most a minor modification of applicants' preferred genus of thermoplastic elastomeric block copolymers. Bird, relied upon initially but then withdrawn, upon reconsideration discloses applicants' preferred genus of adhesive compositions which inherently display sufficient adhesion to a desired component at room temperature to retain the component in its desired location (column 3 lines 43-46), and upon removal of the component from its desired location, the adhesive desirably does not transfer to the component (column 3 lines 63-64). The admissions in the specification are that pressure sensitive adhesive labels for optical discs are well known and it is imperative that the label must also be precisely positioned onto a disc. Also applicants admit that pressure sensitive adhesives can be undesirable in making it unwieldy to position the label and that therefore there has developed a great need to have a repositionable and reusable disc layer which would allow a user to position the label to the disc without difficulty. Accordingly, one of ordinary skill in the optical recording medium art would have more than ample motivation to look to the repositionable adhesive art and utilize

a label coated with a member of the genus of adhesives that are set forth in either EP -263 or Bird in order to claim the formed genus of articles. Note also that with respect to the claimed performance parameter regarding the storage modulus at room temperature which constitutes the Dahlquist criterion, this performance parameter is again believed to be either inherent in either of the reference genus of adhesives or at most an obvious optimization to one of ordinary skill.

Applicants have argued (Response, page 5, third complete paragraph) that there is no \*teaching or suggestion in the references of record to employ a non-pressure sensitive adhesive of the type disclosed in EP -263 (and presumably, Bird) in place of the pressure sensitive adhesives which are typically used for optical recording disc labels. However, the relied upon rejections of record each obtain their motivation from the admissions in the specification, together with the aforementioned sections of each of the references which teach that repositionable adhesives have the desired properties which applicants are searching for. Note that EP -263 teaches adhesives which are useful not only for adhesion to another adhesive, but also to desired substrates, and which retain their properties for long periods of time. With respect to applicants' remarks (Response, page 6, first complete paragraph) of an adhesive composition found at page 4, lines 49-52 of EP -263,

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this has not been relied upon by the Examiner for his rejection. In summary, each of the two prior art references describe broad genres of adhesives that appear to meet the adhesive properties desired by applicants and which are taught to be both repositionable and suitable for use in a wide variety of substrates in a wide variety of environments. Other parameters that are not either expressly or inherently disclosed are each believed to be obvious modifications to one of ordinary skill, in the absence of unexpected results.

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel Zirker whose telephone number is (703) 308-0031. The examiner can normally be reached on Monday-Thursday from 8:30 A.M. to 6:00 P.M. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris, can be reached on (703) 308-2414. The fax phone number for this Group is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.

Dzirker:cdc

October 23, 2003

DANIEL ZIRKER  
PRIMARY EXAMINER  
GROUP ~~1800~~  
1700

*Daniel Zirker*